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William M. Blackstone
Akzo Nobel Pharma Patent Dept.
29160 Intervet Lane
P.O. Box 318
Millsboro, DE 19966

In re Application of :
HURON et al. :
U.S. Application No.: 10/524,242 :
PCT No.: PCT/US03/25358 : DECISION ON PETITION
Int. Filing Date: 13 August 2003 : UNDER 37 CFR 1.47(a)
Priority Date: 13 August 2002 :
Attorney Docket No.: I-2002.022 US :
For: NOVEL COMPOSITION AND :
PROCESSES FOR DELIVERING AN :
ADDITIVE :

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 10 February 2005 to accept the application without the signature of joint-inventor, Mark Pieloch. The \$200 petition fee will be charged to Deposit Account no. 02-2334.

BACKGROUND

On 13 August 2003, applicants filed international application PCT/US03/25358 which claimed a priority date of 13 August 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 February 2005.

On 10 February 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment; and a Petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Item (1) has been satisfied.

Regarding item (2) above, petitioner states that Mark Pieloch has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner states that Mark Pieloch has refused to sign the application. A review of the present petition and the accompanying papers reveals that applicants have not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers to Mark Pieloch. The "Declaration of William P. Ramey, III" states that a copy of the application papers were sent to Mark Pieloch on August 22, 2003. A copy of the cover letter and delivery certificate has been provided. However, petitioner fails to include evidence to demonstrate that the materials were actually received by the nonsigning inventor at his last known address. Where the Office is being asked to accept the silence of the nonsigning inventor as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Further, it appears that the application papers were mailed to Mr. Pieloch's corporate address. In this situation, the application papers should be submitted to the inventor at his last known home address to insure receipt.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Mark Pieloch, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (3) above, a clear statement of the last known address of the non-signing inventor has not been provided. In situations where an inventor does not execute the oath or declaration, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary. (See MPEP §605.03)

As to item (4), a declaration executed by Sebastien Huron and Sandy Cady has been submitted with the present petition. However, the declaration submitted is not in compliance with 37 CFR 1.497(a)(3) which requires that the oath or declaration identify each inventor and the country of citizenship of the inventor. In this case, the declaration does not identify the name, citizenship, and mailing address of the third inventor, Mark Pieloch. Since the declaration does not clearly identify the name and citizenship of the third inventor, it is considered defective under 37 CFR 1.497(a)(3) and 37 CFR 1.63(c)(1).

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459